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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/100,129	06/19/1998	PAUL HAVERSTOCK	23452-034	8225

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EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 04/15/2004

46

Please find below and/or attached an Office communication concerning this application or proceeding.

P26

Office Action Summary

Application No.

09/100,129

Applicant(s)

HAVERSTOCK ET AL.

Examiner

Paul H Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11, 13-19, 21-24 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) 5, 12, 20 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13-19, 21-24 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>42,44</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 5, 8, 15 and 21 are cancelled. Claims 1-4, 6-11, 13-19, 21-24 and 26-33 are now pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-4, 6-11, 13-19, 21-24 and 26-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of

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copending application 09/100,119, now U.S. Patent No. 6,064,977 (hereafter referred to as '977), in view of Flores et al., US Pat. No. 6,073,109. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the copending application.

'977 teaches the invention substantially as claimed, however, '977 does not explicitly teach a workflow module that facilitates one or more object management tasks of the server, wherein the workflow module notifies at least one user that at least one action is required for the one or more non-markup language objects.

In the same field of endeavor, Flores teaches a system for managing business processes using workflow, wherein a workflow module facilitates one or more object management tasks of the server, associated with the one or more non-markup language objects according to one or more predefined calendaring and scheduling functions (Flores, col. 8, line 44 – col. 9, line 64 and col. 16, line 36 – col. 17, line 10), wherein the workflow process notifies at least one user that at least one action is required for the one or more non-markup language objects (Flores, col. 1, line 11 – col. 2, line 14 and col. 13, line 39 – col. 14, line 21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the system, method and electronic storage medium for workflow process as taught by Flores, into the web server having integrated scheduling and calendaring of '977 for the purpose of automating and coordinating distributed business processes.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-11, 13-19, 21-24 and 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flores et al., US Pat. No. 6,073,109 in view of Leone, US Pat. No. 5,745,360.

6. As to claims 1, 8, 15 and 21, Flores teaches the invention substantially as claimed. Flores teaches a server system, a method and electronic storage medium facilitating one or more object management tasks, of a server, associated with one or more non-markup language objects (Flores, col. 1, line 11 – col. 2, line 14), the system comprising:

a server (Flores, fig. 2 and col. 8, lines 34-43);

one or more databases, in communication with the server, comprising one or more non-markup language objects (workflow data objects are stored on databases in communication with the workflow server; see Flores, fig. 2 and col. 8, line 44 – col. 9, line 45. Services are performed on non-markup language objects such as in Lotus Notes environments, see also col. 7, lines 30-44);

a workflow module that facilitates one or more object management tasks of the server, associated with the one or more non-markup language objects according to one or more predefined calendaring and scheduling functions (Flores, col. 8, line 44 – col. 9, line 64 and col.

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16, line 36 – col. 17, line 10), wherein the workflow process notifies at least one user that at least one action is required for the one or more non-markup language objects (Flores, col. 1, line 11 – col. 2, line 14 and col. 13, line 39 – col. 14, line 21).

However, Flores does not explicitly teach the system, method and electronic storage medium further comprising a markup language translator that translates the one or more non-markup language objects to representations of one or more markup language objects in order to enable said at least one user to execute said at least one action notified by the workflow module.

In the same field of endeavor, Leone teaches a dynamic hypertext link converter system wherein non-hypertext documents are translated into hypertext documents in order to provide access to legacy databases (See Leone, col. 1, line 5 – col. 2, line 19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the system, method and electronic storage medium for translating a non-markup language object to a markup language object as taught by Leone, into the workflow system of Flores, for the purpose of enhancing interoperability of legacy systems by enabling operation over the internet.

7. As to claims 2, 9, 19, and 22, Flores-Leone teach the system, method and electronic storage medium, as applied above, wherein the workflow module performs the one or more tasks based on an occurrence of one or more events (the workflow system performs tasks based on occurrence of events such as workflow initiation, schedule or follow-up events; see Flores, col. 8, line 44 – col. 9, line 45; col. 13, line 39 – col. 14, line 21 and col. 15, line 15 – col. 17, line 10).

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8. As to claims 3, 10, 16, 17, 23, and 26-33, Flores-Leone teach the system, method and electronic storage medium, as applied above, wherein the workflow module distributes, routes and tracks an object according to a predetermined process (Flores, col. 5, line 13 – col. 7, line 5; col. 8, line 44 – col. 9, line 45 and col. 11, line 10 – col. 12, line 25).

9. As to claims 4, 11, 18, and 24, Flores-Leone teach the system, method and electronic storage medium, as applied above, wherein a notifying module notifies the system user that an action is required for the one or more objects (Flores, col. 1, line 11 – col. 2, line 14 and col. 13, line 39 – col. 14, line 21).

10. As to claims 6 and 13, Flores-Leone teach a system, method and electronic storage medium having a client/server system comprising a HTTP server module (Leone, fig. 2 and col. 4, lines 6-45).

11. As to claims 7 and 14, Flores-Leone teach a system, method and electronic storage medium having a client/server system comprising a non-markup language server module (non-markup language processing functionality resides on HTTPD server 3; Leone, col. 4, lines 6-45).

Response to Arguments

Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant argued in substance that the prior art of record failed to teach the newly added features in the independent claims regarding "a markup language translator." The new grounds of rejection teaches this feature.

Additionally, the applicant argued that Flores does not teach or suggest translating a non-markup language object in a workflow system... while Leone does not teach or suggest a workflow system..." See Remarks, page 9, lines 3-14. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Applicant's amendment filed June 9, 2003 (paper no. 43) and Applicant's submission of information disclosure statements under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on June 9, 2003 (paper no. 42) and November 24, 2003 (paper no. 44) prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

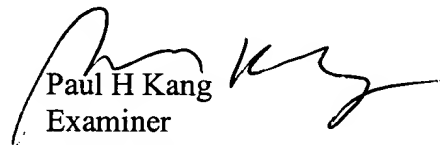
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Paul H Kang
Examiner
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